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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,112	08/15/2001	James E. King	5681-04000	9998
7590 10/18/2004				
B. Noel Kivlin Conley, Rose, & Tayon, P.C. P.O. Box 398 Austin, TX 78767			EXAMINER MCCARTHY, CHRISTOPHER S	
			ART UNIT 2113	PAPER NUMBER

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/930,112	Applicant(s) KING, JAMES E. 	
	Examiner Christopher S. McCarthy	Art Unit 2113	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-16,18-20,22-29 and 31-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40-45 and 52-56 is/are allowed.
- 6) ☒ Claim(s) 1,3-6,11,12,14,16,18-20,27-29 and 31-34 is/are rejected.
- 7) ☒ Claim(s) 7-10,13,15,22-26,35-39,47 and 48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Response to arguments</u> . |

DETAILED ACTION

1. Claims 1, 3-6, 11-12, 14, 16, 18-20, 27-29, 31-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Craig et al. U.S. Patent 6,260,111, as cited in prior office action, which was mailed on 5/3/2004.
2. Claims 7-10, 13, 15, 22-26, 35-39, 47-48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims
3. Claims 40-45, 52-56 are allowed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-6, 11-12, 14, 16, 18-20, 27-29, 31-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Craig et al. U.S. Patent 6,260,111.

As per claim 1, Craig teaches a processing unit connectable to a data communications network, the processing unit comprising a device reader operable to read a supplied network identity from a portable storage device, the processing unit being operable to use the supplied network identity from the portable storage device for communicating via the data communications network, the processing unit being operable to monitor a continued presence of the portable storage device, and, in the event of the removal of the portable storage device from the device reader, to signal a fault state (column 4, lines 28-32; column 8, lines 3-9) and, where a portable storage device having the supplied network identity is not returned to the device reader within a predetermined time following removal of the portable storage device from the device reader, to power itself down (column 8, lines 3-9).

As per claim 3, Craig teaches the processing unit of claim 1, comprising first memory operable to store a default network identity for communication via the data communications network and second memory operable to receive the supplied network identity from the portable storage device (column 3, lines 61-62; column 5, lines 61-67; column 6, lines 38-52), wherein, when the card is not present, the host computer does keep a default communication state that is different than with the card present.

As per claim 4, Craig teaches the processing unit of claim 3, wherein the processing unit is operable on being powered up to determine whether a said portable storage device is present and, where a said portable storage device is present, to copy the supplied network identity from the portable storage device to the second memory and to use the supplied network identity (column 6, lines 57-60).

As per claim 5, Craig teaches the processing unit of claim 3, wherein the processing unit is operable to detect removal of the portable storage device from the device reader and to start a timer running to define a predetermined time (column 8, lines 3-9).

As per claim 6, Craig teaches the processing unit of claim 5, wherein the processing unit is operable to power itself down where a portable storage device having the supplied network identity is not returned to the device reader within the predetermined time following removal of the portable storage device from the device reader (column 8, lines 3-9).

As per claim 11, Craig teaches the processing unit of claim 1, wherein said portable storage device is a data card and the device reader is a data card reader (column 4, lines 21-26).

As per claim 12, Craig teaches the processing unit of claim 1, wherein said portable storage device is a smart card and said device reader is a smart card reader (column 4, lines 21-26).

As per claim 14, Craig teaches the processing unit of claim 1, comprising a service processor, the service processor being programmed to control reading of the device reader (column 6, lines 38-40).

As per claim 16, Craig teaches a control program for controlling the selection of a network identity for a processing unit connectable to a data communications network, the processing unit having a device reader operable to read a supplied network identity from a portable storage device, the control program being operable to select the supplied network identity from the portable storage device for communication via the data communications network, the control program being operable to monitor a continued presence of the portable storage device and, in the event of the removal of the portable storage device from the device

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reader, to signal a fault state (column 4, lines 28-32; column 8, lines 3-9; column 5, lines 21-24) and, where a portable storage device having the supplied network identity is not returned to the device reader within a predetermined time following removal of the portable storage device from the device reader, to power itself down (column 8, lines 3-9).

As per claim 18, Craig teaches the control program of claim 16, wherein the processing unit includes first memory operable to store a default network identity for communication via the data communications network and second memory operable to receive the supplied network identity from the portable storage device (column 3, lines 61-62; column 5, lines 61-67; column 6, lines 38-52), wherein, when the card is not present, the host computer does keep a default communication state that is different than with the card present.

As per claim 19, Craig teaches the control program of claim 18, wherein the control program is operable in response to the processing unit being powered up to determine whether a said portable storage device is present and, where a said portable storage device is present, to copy the supplied network identity from the portable storage device to the second memory and to select the supplied network identity if the portable storage device is present (column 6, lines 57-60).

As per claim 20, Craig teaches the control program of claim 18, wherein the control program is operable to detect removal of the portable storage device from the device reader and to start a timer running to define a predetermined time (column 5, lines 3-9).

As per claim 27, Craig teaches a microcontroller programmed with a control program as recited in claim 16 (column 4, lines 28-32; column 8, lines 3-9; column 5, lines 21-24, 51-67).

As per claim 28, Craig teaches a server computer comprising a device reader, a processor, memory and a microcontroller as recited in claim 27, the microcontroller being operable as a service processor and connected to monitor the device reader to detect the presence of a portable storage device and to read content from the portable storage device (column 4, lines 28-32; column 8, lines 3-9; column 5, lines 21-24, 51-67).

As per claim 29, Craig teaches a method of controlling the selection of a network identity for a processing unit connectable to a data communications network, the method comprising: a device reader reading a supplied network identity from a portable storage device; using the supplied network identity from the portable storage device for communication via the data communications network; monitoring the presence of the portable storage device; and in the event of the removal of the portable storage device from the device reader, signaling a fault state (column 4, lines 28-32; column 8, lines 3-9) and, where a portable storage device having network identity is not returned in the device reader within a predetermined time following removal of the portable storage device from the device reader, powering down the processing unit (column 8, lines 3-9).

As per claim 31, Craig teaches the method of claim 29, wherein a first memory in the processing unit stores a default network identity for communication via the data communications network and a second memory in the data processing unit receives the supplied network identity from the portable storage device (column 3, lines 61-62; column 5, lines 61-67; column 6, lines 38-52), wherein, when the card is not present, the host computer does keep a default communication state that is different than with the card present.

As per claim 32, Craig teaches the method of claim 31, further comprising, in response to the processing unit being powered up, determining whether a said portable storage device is present, and: where a said portable storage device is present, copying the supplied network identity from the portable storage device to the second memory; and selecting the supplied network identity (column 6, lines 57-60).

As per claim 33, Craig teaches the method of claim 32, comprising, in response to detecting removal of the portable storage device from the device reader, starting a timer running to define a predetermined time (column 8, lines 3-9).

As per claim 34, Craig teaches the method of claim 33, comprising powering down the processing unit where a portable storage device having the supplied network identity is not returned in the device reader within the predetermined time following removal of the portable storage device from the device reader (column 8, lines 3-9).

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16, 46, 49, 50, 51 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Current application claims a control program, which embodies an algorithm and is not patentable per se. Applicant is advised to re-state the limitation in words such as a *control program written with computer-readable instructions on a computer-readable medium*.

Response to Arguments

6. Applicant's arguments filed 8/6/2004 have been fully considered but they are not persuasive.

Applicants have argued that Craig does not teach waiting a predetermined time before shutting down the unit. The examiner respectfully disagrees. The applicant states that Craig does teach that the system should immediately be shut down upon card removal. The examiner contends that the immediate response to a card being removed is a predetermined time. In other words, "immediately" is a predetermined time of response to a removal of a card. The reasoning by the examiner is that the opposite of predetermined is undetermined and Craig definitely teaches the time of a removal of a card as to shut down of the system. An undetermined response would not guarantee an immediate shut down, as desired by Craig. Therefore, all rejected claims stand.

Allowable Subject Matter

7. Claims 7-10, 13, 15, 22-26, 35-39, 47-48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims

8. Claims 40-45, 52-56 are allowed.

Reasons for Allowance

9. The following is an examiner's statement of reasons for allowance: When read as a whole, claims 40, 43-45, 52, 55, 56 are allowable with respect to the following limitations:

With respect to claim 40, the primary reason for allowance is the limitation of wherein, following removal of the portable storage device from the device reader, the processing unit is operable to detect a new presence of a portable storage device, to read a network identity from the newly present portable storage device, and to compare the read network identity to the supplied network identity in the second memory.

With respect to claim 43, the primary reason for allowance is the limitation to start a timer running to define a predetermined time, and, in the event of the removal of the portable storage device from the device reader, to cause a fault light to operate during running of the timer to signal a fault condition.

With respect to claim 44, the primary reason for allowance is the limitation the processing unit comprising a device reader operable to read a supplied network identity comprising a MAC address from a portable storage device.

With respect to claim 45, the primary reason for allowance is the limitation server comprising a device reader operable to read a supplied network identity from a portable storage device, the server being operable to use the supplied network identity from the portable storage device for communicating via the data communications network.

With respect to claim 52, the primary reason for allowance is the limitation following removal of the portable storage device from the device reader, the control program responding to

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a new presence of a portable storage device to read a network identity from the newly present portable storage device and comparing the read network identity to the supplied network identity in the second memory.

With respect to claim 55, the primary reason for allowance is the limitation in the event of the removal of the portable storage device from the device reader, causing a fault light to operate during running of a timer to signal a fault condition.

With respect to claim 56, the primary reason for allowance is the combination of the limitation of a method of controlling the selection of a network identity comprising a MAC address for a processing unit connectable to a data communications network, and using the supplied network identity from the portable storage device for communication via the data communications network.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher S. McCarthy whose telephone number is (571) 272-3651. The examiner can normally be reached on M-F, 8 - 4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on (703)305-9713. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csm
October 12, 2004


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